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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,048	07/10/2001	Michael Lee Vatter	8163	7755

27752 7590 03/19/2002

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/902,048

Applicant(s)

VATTER, MICHAEL LEE

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 3.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4. 6) ☐ Other:

DETAILED ACTION

Claims 1-12 are pending.

Information Disclosure Statement

Applicant's submission on 28 February 2002 (paper #4) of a duplicate copy of the Information Disclosure Statement, originally submitted 10 September 2001 (paper #2) is respectfully acknowledged. The references have been considered, and an initialed copy of the IDS is attached.

Specification

1. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). The material in question is the description of solubility parameters and means for determining them, as referenced in the specification (see page 9, lines 6-10). It is the position of the examiner that the material

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is essential rather than background material because claim 1 specifically refers to the solubility parameter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1 and 12 are rejected due to the term "preferably". A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation in the same claim is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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5. Claims 1 and 12 are rejected for being confusing because the weight percentage of water is inconsistent with the weight percentages of the other components of the composition. Since the compositions are minimally comprised of at least about 10% solvent, the compositions cannot contain about 95% water. The rejection can be overcome by changing the minimum amount of solvent to about 5%, or changing the maximum amount of water to about 90%.

6. Claim 7 is rejected for being confusing due to the phrase "composition further comprises further comprising". The rejection can be obviated by removing "further comprising".

7. Claim 10 is rejected for being vague due to the term "combination". It is unclear if the term requires the non-emulsifying and emulsifying crosslinked siloxane elastomers to be covalently attached to each other, or on the other hand, if the term only requires a physical mixture of separate elastomers.

8. Claim 11 is rejected due to the phrase "vitamins and derivatives thereof". The metes and bounds of the term derivatives are unclear, and the specification does not provide a standard for determining whether a given compound is a vitamin derivative, such that one of ordinary skill in the art would not be apprised of the scope of the invention. Claim 11 is also rejected for being confusing due to the term "such". If the term is meant to be part of the phrase "such as", then the term renders the claim indefinite because it is unclear whether the limitations following the term are part of the claimed invention. See MPEP § 2173.05(d). Additionally, claim 11 is rejected for being

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confusing due to the phrase "agents suitable for aesthetic purposes". It is unclear what agents are included or excluded by this phrase.

9. Any remaining claims are rejected for depending from indefinite base claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz et al (US Pat. 5,654,362) in view of Dreschler et al (US Pat. 6,071,503).

13. Schulz teaches silicone oils and solvents thickened by silicone elastomers. The elastomers are made by crosslinking silicone-containing precursors (see col. 2, lines 1-59). The silicone oils include polydimethylsiloxane, also known as dimethicone (see col. 4, lines 28-45). Common ingredients to be used with the elastomers of Schulz include propylene glycol (see col. 5, lines 1-5). Glycol functional siloxane fluids are taught as

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useful with the elastomeric compositions, meeting the limitation of a dimethicone copolyol (see col. 4, lines 45-55). Schulz teaches that the compositions are useful for personal and facial cleansers and that they function as color cosmetic removers (see col. 7, lines 41-60). Additionally, Schulz teaches that the compositions are useful as delivery systems for oil and water-soluble substances such as vitamins. Table I includes an emollient (see col. 6, lines 44-67). The reference lacks teaching methods of makeup removal that specifically include transfer resistant makeup as well as compositions that include a substrate such as a tissue.

14. Dreschler teaches transfer resistant cosmetic compositions. The compositions of Dreschler contain a silicone gum or resin base (see Examples 1 and 2, col. 15, line 20 through col. 16, line 30). Dreschler teaches that the compositions may be removed by applying petrolatum or a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with a tissue (see col. 15, lines 15-18).

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions and methods for makeup removal as taught by Schulz by removing transfer resistant makeup with the further use of a tissue in order to benefit from the removal of transfer resistant makeup as taught by Dreschler.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/850,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are drawn to compositions comprising siloxane elastomers, solvent, and optionally water. The limitation of "one or more layers of water-insoluble substrate" of the instant claim is taken by the Examiner to be another way of claiming a composition that "further comprises fillers" of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

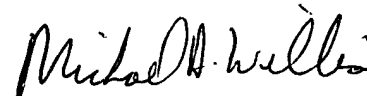
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walter et al (US Pat. 5,227,242) discloses multifunctional facial tissue that contains a silicone compound. Specific suitable silicone compounds include polydimethyl siloxanes. The reference is silent with respect to siloxane elastomers.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

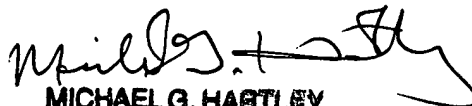
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

March 14, 2002



MICHAEL G. HARTLEY
PRIMARY EXAMINER